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generating multiple standing orders, the multiple standing orders including the first standing order.

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170. (amended) The method of Claim 157, wherein said receiving further comprises receiving said first order for products or services into a shopping cart and further wherein said generating further comprises generating said first profile from said shopping cart in response to selection of a link associated with the shopping cart.

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183. (amended) The electronic commerce of Claim 181, wherein said order management system is further operative to:
generating multiple standing orders, the multiple standing orders including the first standing order.

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188. (amended) The electronic commerce system of Claim 174, wherein said order management system is further operative to receive said first order for products or services into a shopping cart and generate said first profile from said shopping cart in response to selection of a link associated with the shopping cart.

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189. (amended) The electronic commerce system of Claim 174, wherein said first order for products or services may be specified in eaches or bulk.

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195. (amended) In a method for facilitating electronic ordering of a product or service in response to a user selection through a network, said network comprising at least one server computer capable of communicating with a browser system located at a remote client computer, an improvement comprising:
establishing a standing order in response to the selection of the product or service.

Please add new claims 197-199 as follows:

--197. (new) A method for facilitating electronic commerce in an electronic commerce system through a network, said network comprising at least one server computer capable of communication with a browser system located at a remote client computer, said method comprising:

(a) receiving a standing order process selection;

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(b) providing standing order profile information, the standing order profile information operable to allow a user to set up an automated order system that sends products and/or services to the user at regular intervals, the standing order profile information provided in response to (a); and

(c) establishing long-term orders of the products and/or services as a function of the regular intervals.

198. (new) The method of Claim 197 further comprising:

(d) providing a shopping basket page with a link to the standing order process selection, wherein (a) occurs in response to selection of the link; and

(e) placing any items in the shopping basket page in the standing order profile information prior to (b); and

(f) receiving removal information, if any, for removing one or more of the items from the standing order profile.

199. (new) The method of Claim 197 further comprising repeating (a), (b) and (c) for multiple standing orders associated with a same user.--

Please cancel claims 169 and 187.

RESPONSE

This is a response to the Office Action dated December 4, 2002. Claims 157-196 are pending in the application. In the Office Action, the Examiner rejected claims 157, 163-165, 169, 170, 174, 181, 182, 187, 188, 192, 193, 195, and 196 pursuant to 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, claims 157, 161, 163-165, 167, 168, 170-174, 183, 189-192, and 195 were rejected pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. In addition, claims 157-196 were

rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,415,265 (“Shell”) in view of AMWAY® Products Delivered on your Schedule, Customer Order Worksheet (“Amway”).

The rejections from the Office Action of December 4, 2002 are discussed below in connection with the various claims. No new matter has been added. Reconsideration of the application and claims is respectfully requested in light of the following remarks.

I. REJECTIONS UNDER 35 U.S.C. § 112, first paragraph

A. Claims 170 and 188:

Claims 170 and 188 have both been amended. The Examiner rejected the use of “single action by the user.” The “single action by the user” has been replaced with “selection of a link associated with the shopping cart.” This selection of a link for generating a profile is clearly disclosed in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the “shopping basket page 110 preferably includes additional links to ‘Return’ 113, ‘Continue Checkout’ 115, and ‘Standing Order’ 116.” (page 89, lines 6-7). “By choosing Standing Order 116, the user is forwarded to a screen that allows the user to create a new standing order profile. . . . All items in shopping basket page 110 are placed in the new profile. User then has the option of removing items from the newly created profile.” (page 89, lines 14-20).

B. Claims 157, 174, 192 and 195:

Claims 157, 174, 192 and 195 are described in the specification in such a way as to enable one skilled in the art to make and use the invention. The Examiner alleges that the claims refer to “product profiles,” then cites to various profiles mentioned in the specification and concludes with an allegation that the specification does not disclose how such “product” orders and profiles are generated.

Claims 157, 174, 192 and 195 refer to a profile comprising the order (claims 157 and 174), establishing an automated order (claim 192) and establishing a standing order (claim 195). A “product profile” is not claimed. For claims 157 and 174, the profile includes the order. For claim 192, a product or service is repetitively sent in response to the automated

order. For claim 195, the standing order is established in response to the selection of the product or service. While the profile, automated order or standing order relate to a product, a product profile is not claimed.

The specification describes how to make and/or use a product order and how to make and/or use profiles, automated orders and standing orders. Regarding making a product order, various examples are disclosed in the specification. One example is shown in Fig. 9 and described at page 88, lines 6-22. In particular, “a product list 90 is used for product browsing and shopping.” (page 88, line 6). “In order to select a product for purchase, a user fills in a quantity 92 on product list 90. Upon selecting the quantities for purchase for a plurality of products, the user can then initiate the Add to Basket link 94, by double clicking a mouse, for example, to add the selected products to a shopping basket.” (page 88, lines 19-22). After proceeding “to checkout, the registered user is forwarded to an order preview page.” (page 90, lines 6-7). This example clearly indicates one way to make a product order.

The specification clearly indicates how to make and/or use profiles comprising an order and a recurrence of the order, automated orders and standing orders. In particular, the “shopping basket page 110 preferably includes additional links to ‘Return’ 113, ‘Continue Checkout’ 115, and ‘**Standing Order**’ 116.” (page 89, lines 6-7). “By choosing **Standing Order** 116, the user is forwarded to a screen that allows the user to **create a new standing order profile**. Typically, a **standing order profile** allows a user to set up an **automated order** system that sends products and/or services to the user at regular intervals, which are selected by the user. Such **standing orders** provide an efficient method for establishing long-term orders of products and/or services from the marketing system. All items in shopping basket page 110 are placed in the new **profile**. User then has the option of removing items from the newly created **profile**.” (page 89, lines 14-20). “The E-Commerce site . . . features an order management system that includes, but is not limited to, the following: . . . support for **recurring orders**.” (page 113, lines 20-23). “The **standing order program (SOP) profiles** are maintained on the mainframe. . . . The **standing order** functionality can access the information maintained in the **SOP profiles**” (page 115, lines 14-20). Table 3 in the Network Communications Configuration section indicates that

Recurring Order Management is performed by three different systems (page 141). The systems and methods for making and using a standing order, automated order and profiles including an order and a recurrence of the order are disclosed.

C. Claims 157, 163, 164, 165, 174, 181, 182, 183, 195 and 196

Claims 157, 163, 164, 165, 174, 181, 182, 183, 195 and 196 are described in the specification in such a way as to enable one skilled in the art to make and use the invention. The Examiner alleges that it is not clear how a recurring or standing order can recur once and how applicant distinguishes an order that occurs once versus an order that occurs more than once. The Examiner also alleges that the specification does not describe how recurrence may be detailed by the shopper, including frequency of order, how many times to fill the order or how often the recurring order may be shipped.

The recurrence of an order is disclosed in the specification. First, the specification teaches that a **standing** order may be used where the ordered products or services are sent at regular intervals (i.e. more than once). For example, “a standing order profile allows a user to set up an automated order system that sends products and/or services to the user at regular intervals, which are selected by the user.” (page 89, lines 15-17). Second, the specification teaches that a **standing** order may be used where the ordered products or services are sent once (e.g., once at a future time). For example, “users may also have multiple standing orders and the ability to add an item to a standing order on a one-time basis.” (page 115, lines 13-14). The specification clearly teaches how recurring or standing orders can recur once (i.e. total of twice – initially and a recurrence) or multiple times or more than once (i.e. repeated more than once – 3 or more time total).

The detailing of the frequency, how many times to fill the order and how often the recurring order may be shipped is also disclosed in the specification. How many times and how often to fill the order is disclosed in the quotes above: once (“users may also have . . . the ability to add an item to a standing order on a one-time basis,” page 115, lines 13-14) or more than once (“at regular intervals,” page 89, lines 15-17). The frequency of the order is disclosed in the quotes above: “at regular intervals, which are selected by the user.”

Selection of the regular intervals by the user supports the recurrence interval of claims 163, 165, 181 and 183 and the regularity of the interval of claims 164 and 182.

Not disclosing how to enter monogram requests in a recurring order profile does not result in not disclosing how to enter a recurring or standing order. As described above, the specification discloses how to establish a standing order by selecting products, selecting a standing order link, loading the standing order with the selected products and arranging for shipment at one or more user specified intervals.

II. REJECTIONS UNDER 35 U.S.C. § 112, second paragraph

A. Claims 157, 165, 174, 183 and 192

Claims 157, 165, 174, 183 and 192 particularly point out and distinctly claim the subject matter. The Examiner alleges that derivatives of “automatic” in these claims render the claims indefinite since the term is not defined by the claims and the specification does not provide a standard. Automatic has an ordinary meaning and a meaning in the art as something that is self-acting, such as done by a machine. Automation is a common term used with electronic systems, so is clear and definite. The specification supports this ordinary meaning. “Typically, a standing order profile allows a user to set up an automated order system that sends products and/or services to the user at regular intervals.” (page 89, lines 15-17). The context of the claims also supports this ordinary meaning. The methods and systems of these claims are for facilitating electronic commerce in an electronic commerce system. The system sends products and/or services at regular intervals automatically or in a self acting manner. Automatic is used in the claims to describe how an order recurs. Thus, some aspect of the recurrence is self-acting or performed by the system, not the user. Further relative information for the burden between the system and the user is not necessary for the clarity of these claims. The specification clearly indicates user set-up of the profile for automatic recurrence followed by automatic recurrence or self-acting recurrence without manual initiation by the user. Given the ordinary meaning and the context of the term, automatic is clear and definite.

The term “automatically” has been removed from claims 165 and 183.

B. Claims 157, 161, 163-165, 167, 168, 170-174, and 183:

Claims 157, 161, 163-165, 167, 168, 170-174, and 183 particularly point out and distinctly claim the subject matter. The Examiner alleges that the “first” order and “first” profile are rendered indefinite in light of the “second” order and “second” profile of claims 165 and 183. While use of first and second to distinguish between different occurrences of the same term is common in patent claims, the use of “second” has been removed by amendment to claims 165 and 183 to avoid further argument. The “multiple standing orders” is disclosed at page 115, lines 13-14: “users may also have multiple standing orders.” (page 115, lines 13-14).

C. Claims 157, 174, 192 and 195:

Claims 157, 174, 192 and 195 particularly point out and distinctly claim the subject matter. The Examiner objected to the use of “client” in two different contexts: client selection and remote client computer. Using a same word in two different phrases does not render the claims indefinite. A “client selection” is clearly different than a “remote client computer,” so a person of ordinary skill in the art would find the claims clear. Requiring no use of term in two different phrases would lead to unnecessary complication in claims and would likely make claims less clear.

D. Claim 189:

Claim 189 was rejected for a typo of “caches” that should be “eaches.” Applicants’ copy of the preliminary amendment indicates a correct spelling. To avoid further delay, the typographical error is inserted into claim 189 and corrected as amended herein.

E. Claims 171-173 and 189-191

The Examiner alleges that the specification does not teach how the terms “bulk,” “cases,” “unit,” and “lot quantities” differ from each other or the ordinary meaning of the terms and cites the proposition that “a term in a claim may not be given a meaning repugnant to the usual meaning of that term.” First, the claims in no way suggest a meaning for any of the terms that is contrary to the usual meaning. In fact, applicants intend for each of the

claims to have the ordinary meaning. Second, using different terms in different claims does not require a comparison of the terms. The terms have their ordinary meaning. Using “bulk” in claims 171, “cases” in 172, and “lot quantities” in claim 173 does not mean these terms are entirely different in meaning. Given the ordinary meaning, particular orders of products or services may be only one or multiple of bulk, cases or lot quantities. A person of ordinary skill in the art would find these terms to be clear and definite. Repetition in different claims with possible overlapping meanings does not make the claim terms indefinite.

III. REJECTIONS UNDER 35 U.S.C. § 103(a)

Independent claims 157, 174, 192, and 195 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shell in view of Amway. Shell was filed on June 30, 2000. Shell is a continuation-in-part of U.S. Patent No. 6,134,533, filed Nov. 25, 1996. However, the earlier filed Shell parent case was not cited by the Examiner in this rejection. The above captioned application claims priority as a continuation to the filing date of Feb. 29, 2000. This parent application filed on Feb. 29, 2000 and the above captioned application include the same substantive disclosure of standing orders. Shell was filed four months after the above captioned application’s priority date. Accordingly, Shell is not prior art and the rejection should be withdrawn.

Independent claims 157 requires generating a profile that specifies a recurrence of an order so that the order automatically recurs one or more times. Likewise, independent claim 174 requires an order management system operative to generate a profile that specifies a recurrence of an order so that the order automatically recurs one or more times. Similarly, independent claim 192 requires repetitively sending a product or repetitively providing a service in response to establishing an automated order. In a similar manner, independent claim 195 requires establishing a standing order. A standing order is an order that repeats or recurs.

Contrary to the allegation by the Examiner, Shell does not suggest automatically repeating an order, an order that automatically recurs or a standing order. Shell discloses an automatic shipment system for distribution (col. 1, lines 45-48; and col. 3, line 66-col. 4, line 5). A server issues shipping orders to send a product to the customer and/or vends an

electronically transferable product directly to the customer's computer (col. 2, lines 10-18). The products or services are provided in response to a purchase of the product using the system (col. 4, lines 15-21). The purchaser establishes a connection, selects a product, and authorizes payment (col. 5, lines 43-67). Any product back-order or availability information is provided to another server (col. 2, lines 28-31). Customer support is provided for complaints, order cancellation, exchanges and returns (col. 3, lines 6-8). Shell is directed to a process and system for single orders or transactions (see col. 6, line 1). The customer support is for making changes to a single order. Shell provide for automated or "on-line" multi-level vending where a user connects and places each order. Shell does not provide for automatic repetition of an order, automatic recurrence of an order or a standing order.

Shell lacks disclosure of an order profile since Shell is directed to processing individual orders, not a recurring, repeating or standing order. Shell tracks the information needed, such as shipping, payment, commissions and products, for each order, but does not suggest a profile for the automatic recurrence or repetition of an order.

A person of ordinary skill in the art would not have combined Shell with Amway to provide the Amway reference's particulars of start date, end dates and quantities. The Examiner indicates the motivation to combine is that orders and quantities should be defined as much as possible in commerce. However, Shell discloses the needed specificity for orders as processed by Shell. Shell does not suggest an automatically recurring or repeated order, so there is no reason to provide the start and end dates in the system of Shell. The motivation cited by the Examiner is lacking as Shell provides very specific information for the type of order processing performed by Shell.

A person of ordinary skill in the art would not have used the information from the Amway reference with the system of Shell for an additional reason. Shell teaches away from the approach used by the Amway reference. Shell notes in the Background section that "all related prior art has required the involvement of a registered seller or operator with privileges to make sales entries to the computer" (col. 1, lines 59-61). The Amway reference is directed to Amway distributors (i.e. registered sellers) (page 3). Since Shell teaches away from the Amway reference, a person of ordinary skill in the art would not have used the teachings of Amway with Shell.

Dependent Claims 158-173, 175-191, 193, 194 and 196 were also rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Shell in view of Amway. Dependent claims 158-173, 175-191, 193, 194 and 196 should be allowed for the reasons set out above for the independent claims. Applicants therefore request that the Examiner withdraw this rejection of these claims. Further limitations of the dependent claims are not disclosed by either of the Shell or Amway references. For example, neither discloses: receiving multiple orders as claimed in claims 165 and 183; user modification of the profile as claimed in claims 166-169 and 184-187; generating a profile as defined in the claims from a shopping cart as claimed in claims 170 and 188; and a member or IBO as claimed in claims 162 and 178. As indicated by the Examiner, Shell does not disclose a member and an IBO. The Examiner notes that Shell discloses different levels of commission. However, "member" and "IBO" are specific terms. For example, member is defined in the specification as "eligible to buy products at a Member price and is not eligible to earn compensation." Providing different levels of compensation as done in Shell does not suggest a member or someone eligible to receive a discount price but not eligible to earn compensation.

IV. NEW CLAIMS

With this response, new claims 197-199 have been added. These new claims add no new matter and are supported by the specification (see page 89, lines 14-20 and page 115, lines 12-20).

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

V. INFORMATION DISCLOSURE STATEMENTS:

Enclosed are copies of an Information Disclosure Statement and 1449 submitted with the application when filed. An Examiner signed copy of the 1449 has not yet been received.